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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/451,319

11/30/1999

ROBERT M. MOORE JR.

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7590

02/15/2011

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PATENT DEPARTMENT  
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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/451,319

**Applicant(s)**

MOORE ET AL.

**Examiner**

ALTON N. PRYOR

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 131-151 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 131-151 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-C306)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's arguments filed 10/4/10 have been fully considered but they are not persuasive. Previous rejections and objections not addressed below are withdrawn.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 133,135-151 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "at least about" in claim 133 line 2, claim 135 line 4, claim 142 lines 4-5" is a relative term which renders the claim indefinite. The term "at least about" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 131-151 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The citation of "the bromine of (i) being the only source of bromine used in the process" appears to be new matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 131-151 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodenough (3,558,503; 1/26/07) in view of Dallmier and McKinnie declaration.

Goodenough teaches a method of producing an aqueous solution having bromine values of about 0.01 to about 100,000 ppmw useful for bleaching processes, treating swimming pools and disinfecting processes (column 1 lines 13-61). Goodenough teaches a method of producing an aqueous bromine solution comprising providing an aqueous solution of bromine and contacting therewith a bromine stabilizer such as sulfamic acid plus an amount of hydroxide such as magnesium hydroxide sufficient to achieve a final pH ranging from about 8 to about 10 (column 2 lines 1-40). Note, the mixing of magnesium hydroxide with sulfamic acid result in an alkaline metal salt of sulfamic acid which is functionally equivalent to the instant alkali metal salt (sodium) of sulfamic acid. According to Moore's own expert, Dr. McKinnie, the reaction taught in Goodenough would be exothermic. Goodenough also teaches that the molar ratio of bromine to nitrogen (Br<sub>2</sub>:N<sub>2</sub>) ranges from about 2 to about 0.5, which would

have indicated to an artisan that the atomic ratio of nitrogen to active bromine (N:Br) ranges from about 0.5 to about 2 (column 1 lines 66-69).

Goodenough's method of making a final solution having a bromine content of about 100,000 ppmw differs from the method recited in Moore's claim 61 in the pH of the resulting biocide composition. That is, Goodenough's method yields a biocide having a pH of from about 8 to about 10 (Example 3) whereas Moore's claimed method yields in a biocide having a pH ranging from 12.0 to 14.0. Thus, as pointed out by Moore, "the question is whether the prior art provided that motivation to modify the method of Goodenough with a reasonable expectation of success". The record indicates that the answer is affirming.

Dallmier discloses a process that "improves on the Goodenough et al. reference by means of a safer, easier, and more economical process." (column 2 lines 45-47). As confirmed by Moore's own expert, Dallmier suggests that a sulfamic acid stabilized hypobromite such as N-bromosulfamate can be stored in a high pH solution ranging from about 8 to about 14 and more preferably from about 11 to about 14 with minimal suspected carcinogen bromate formation. (column 3 lines 28-3; column 4 lines 47-49; column 9 line 65 – column 10 line 60). As taught by Dallmier, the formation of bromate occurs from a reaction involving hypobromite as a reactant and stabilized hypobromite (column 3 lines 24-26; column 10 lines 1-8).

Hence, an artisan would have been motivated to combine the teachings of Goodenough and Dallmier. It would have been obvious to modify Goodenough's process to include a step of increasing the pH of the final solution to 12-14 as indicated

in Dallmier in order to minimize the formation of the suspected carcinogen bromate during storage, thus arriving at a method encompassed by Moore's claims 61-65.

The subject matter of Moore's claim 64 is made obvious in view of the prior art. Claim 64 recites an active bromine content of "at least about 100,000 PPM (wt/wt)" and an atomic ratio of nitrogen to active bromine of "greater than 1," which is made obvious over the prior art, because the prior art ranges overlap the claimed ranges.

*Response to Applicants' argument*

Applicants have amended claims to recite "the bromine of (i) being the only source of bromine used in the process." This amendment appears to be new matter.

Applicants argue that Dallmier refutes the technology provided by Goodenough and leads to us of processing that is foreign to that of Goodenough. Dallmier discloses away from a process wherein elemental bromine is charged into a reaction solution. Dallmier uses bromide plus an oxidant rather than elemental bromine. Dallmier emphasizes that it is critical to use the particular sequence of operations depicted by Dallmier that are not critical in Goodenough et al. Dallmier. The process in the Goodenough reference could not achieve the increased bromine levels as the order of reagent in Goodenough et al. was deemed not critical to the operation of the process. Dallmier, not Goodenough et al., teaches how to avoid bromate formation. Therefore, an artisan in the field would have been motivated to employ reaction steps set forth in Dallmier rather than those set forth in Goodenough and Goodenough et al. are not combinable. Applicants employ *In re Kuehl* to support their position. These are previous arguments of the Applicants that were previously addressed by the Examiner. The

Examiner reiterates that it is important to note that one of the main reasons for employing Dallmier is to provide the motivation for arriving at biocidal composition having a pH ranging from 12 to 14. For this reason it would have been obvious to employ the teaching of Dallmier to raise the pH of Goodenough's compositions to 12 to 14 to avoid carcinogen bromate formation. No data has been provided by the Applicants with respect to the significance of the instant ordering of steps in the formation of the liquid biocide.

Applicants argue that Goodenough teaches a final solution having a maximum of 100,000 ppm Br. However, in Goodenough the preferred embodiments have a maximum of 50,000 ppm bromine. Whereas, instant claims recite at least about 100,000 ppm Br<sub>2</sub>. The Examiner argues that instant claim 131 does not teach a ppm level of Br<sub>2</sub>. In addition, Goodenough teaches 100,000 ppm Br<sub>2</sub> which makes instant invention comprising at least about 100,000 ppm Br<sub>2</sub> obvious.

Applicants argue that Goodenough et al. teach stabilized bromine solutions exhibited a decrease in halogen activity from the initial concentration of 1% to 0.77% after 14 days representing a halogen activity loss of 23%. On the other hand, the instant stabilization process improved on the prior art as the decline of active halogen ingredient was only 1% after 84 days. What is the halogen activity loss in instant process after 14 days?

The Applicants reiterates that Goodenough and Dallmier disclose incompatible processes for forming halogen-based biocidal solutions. In Goodenough addition steps are not critical. In Goodenough, the halogen is added to the solution second or last. On

the other, Dallmier discloses that the addition steps are critical. In Dallmier, the halogen is added first. In both Dallmier and Goodenough the base is added last to attain their wanted pH. Dallmier teaches that the base should be added last and supports that it is unfavorable to conduct processes for formation of the biocide at elevated pH values. Dallmier supports that bromine value should be stabilized prior to base addition. Applicants argue that Goodenough and Dallmier use different bromine sources. Dallmier teaches away from the combination with Goodenough. The Examiner reiterates that it is important to note that one of the main reasons for employing Dallmier is to provide the motivation for arriving at biocidal composition having a pH ranging from 12 to 14. For this reason it would have been obvious to employ the teaching of Dallmier to raise the pH of Goodenough's compositions to 12 to 14 to avoid carcinogen bromate formation. No data has been provided by the Applicants with respect to the significance of the instant ordering of steps in the formation of the liquid biocide.

The Applicants argue that claim 131 makes clear that the product formed is produced from a process consisting of the step of cofeeding into a reactor comprising specified materials so that in effect, at all times during and after the feeding the pH of the formulation exits always at about 12 to about 14, i.e. the pH is obtained solely in the preparation process as claimed. The Applicants argue that claims 131-134 present a completely different scenario from that upon which the Board's Findings of Fact and Conclusions of Law were based, i.e. previous claims 61-65 (now cancelled claims 61-65) employed "comprising" language which permitted the inclusion of additional active

step(s) such as the modification of Goodenough's process to include a further step of increasing the pH of the solution from 8-10 to 12-14 as suggested by Dallmier to avoid the production of carcinogen bromate. Now turning to Instant claims 131-134 employing "consists of" language, an artisan in the field would not have been expected to modify the Goodenough's process to include the additional step of increasing the pH of the solution to 12-14 as suggested by Dallmier in order to reduce the formation of potentially carcinogen bromate during storage to arrive at the instant invention since the "consists of" language closes the claims. Dallmier and Goodenough teach separate feeding lines. The Examiner maintains that after reading Goodenough in light of Dallmier an artisan in the field would have been motivated to carry a process of producing a biocide in the single step of cofeeding into a reactor comprising sulfamic acid, water and magnesium hydroxide (i) bromine and (ii) an alkali metal solution to maintain the pH at about 12 to about 14. One would have been motivated to do this in a single step to avoid carcinogenic bromate formation. The number of feeding lines is a experimental design choice. One skilled in the art would know that several feeding line scenarios could be employed to produce the instant liquid biocide composition.

Applicants reiterate that claims 135-151 include static mixing, mechanical stirring, withdrawing product intermittently and using multiple reaction vessels. The prior art does not teach these steps. The Examiner maintains that it would have been obvious to include steps of mechanical stirring, static mixing, removing product intermittently and using multiple reaction vessels at the time of the prior art invention. One would have

been motivated to do include the steps in a pilot or commercial process in order to obtain high production rates.

Applicants argue that McKinnie compares the amounts of N-bromosulfamate and N-chlorosulfamate produced when using bromine chlorine versus bromine and chlorine. The instant claims employ bromine, not bromine chloride or bromine and chlorine. The Examiner points out that the 3rd line of claim 131 employs the term "containing" which allows for the inclusion of bromine chloride or bromine and chlorine. Independent claims 135 and 142 line 2 employs the term "comprises" which allows for the inclusion of bromine chloride or bromine and chlorine.

#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/  
Primary Examiner, Art Unit 1616